

REMARKS

Responsive to the Office Action dated June 1, 2004, Applicants have, by the above amendments, amended claims 1-3, 5, 9, 10 and 14, and added new claims 21-26 for consideration by the examiner. Accordingly, remaining in the application is independent claim 1 with its dependent claims 2-8 and 21; independent claim 9 with its dependent claims 12 and 13; independent claim 10 with its dependent claim 11; independent claim 14 with its dependent claims 15-20; and independent claim 22 with its dependent claims 23-26.

Examiner Interview

The examiner granted a telephone interview to Applicants' attorney on August 10, 2004, and Applicants along with their attorney wish to thank the examiner for his time and comments. The discussion during the interview centered around the §112, 2nd paragraph rejections and proposals for language that would be suitable to overcome the same. The references cited in the Office Action were also briefly discussed.

Information Disclosure Statement

Submitted with the subject application was an Information Disclosure Statement and PTO-1449 form. A copy of the PTO-1449 form having markings to indicated that the form was reviewed by the examiner was not included with the Office Action. During the above-mentioned telephone interview, the examiner indicated that a marked copy would be included with the next official paper.

Allowable Subject Matter

The Office Action indicates that claims 10, 11 and 19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and suitably amended to overcome the rejection(s) under §112, second paragraph. By the above amendments, claim 10 has been rewritten in independent form and amended to overcome the §112 issues. As such, claim 10 and its dependent claim 11 are allowable.

Rejection under §101

Paragraph 1 of the Office Action indicates that claims 1-20 are rejected under 35 U.S.C. §101 stating that the claimed invention lacks patentable utility. Applicants respectfully submit that the usefulness of the claimed method of playing a game lies in the fun and enjoyment of playing the game, and that such utility is readily apparent and well established. In support of the rejection, the Office Action recites the terms “unclear” and “not clear.” However, Applicants respectfully assert that clarity is an issue that is more properly considered under §112, second paragraph. For at least the above reasons, Applicants respectfully traverse the rejection under §101.

Rejection under §112, 2nd paragraph

Paragraphs 2 and 3 of the Office Action state that claims 1-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite, indicating that the structure of “the categories” in claims 1, 9 and 14 is unclear. More specifically, the Office Action states that it is unclear how the categories are presented and, additionally, how the responses are recorded. The Office Action also indicates that the terminology in claims 2 and 3 is inconsistent with the specification rendering the claims confusing. Furthermore, the Office Action states that there is no antecedent basis for “two or more teams” in claims 5 and 6. By the present amendments, the claims enumerated in the foregoing discussion have been amended to overcome the above rejections based upon the language discussed with the examiner during the interview and are believed to be in proper form.

Rejections on the Art

The Office Action indicates that claims 1-3 and 5-8 are rejected under 35 U.S.C. §102(a) as being anticipated by Forrest, which is directed to an electronically interactive location-based multimedia game system and method. Among other things, the Office Action states that Forrest teaches recording answers by players at column 5, lines 65-67 and ranking of answers at column 8, lines 23-26. After a thorough review of Forrest, however, Applicants respectfully submit that at least these features are not taught by this reference.

In column 5 at about lines 66-67, Forrest states that “the host poses a question and team players select answer(s) to the multimedia question posed.” [Emphasis added.] That is, the players in Forrest do not record answers on a recording medium as recited in the subject claims, as presently amended. Rather, the players in Forrest merely select an appropriate graphic image, drawing, shape, message or combination thereof from those presented on the game terminal. As such, the step of recording one or more responses is simply not taught by Forrest.

Additionally, Forrest states in column 8 at about lines 23 that “[o]ne player may know half the answer and another player may know the other half of the overall correct answer. According to this scenario, the overall correct answer is obtained only by collaboration.” The Office Action suggests that this passage teaches the ranking of recorded responses in an order, as recited in the subject claims. In attempting to understand the examiner’s reliance on this passage, one possible interpretation could be that multiple portions of an answer are to be selected from the graphics presented on the game terminal and these graphics must be selected in a certain order to form the desired answer. This is not clearly taught by the cited passage, and even if this interpretation is correct and taught in Forrest, this concept is quite different than the step recited in the subject claims. That is, recording a plurality of responses and ranking those responses in an order is significantly different than selecting numerous graphics from a group of provided graphics in a logical order to form a specific answer. As such, at least the step of ranking the responses is not taught by Forrest.

What’s more, Forrest teaches collaboration between players, as recited above with reference to column 8 at about line 25, for example. Such discussion or collaboration between players is to be avoided in the subject method. The concept is that each player records and ranks his/her own responses. The ranked responses are then compared to determine a score. If discussion or collaboration between players was to be permitted, each team would always get the maximum score and the fun and challenge of the subject game would be lost. Thus, the step of comparing ranked responses between the two players of a team, as recited in the claims of the subject application, is not taught by Forrest. For at least the foregoing reasons, the subject claims, as presently amended, define over the teachings of

Forrest.

The Office Action further indicates that claims 1-9, 12-18 and 20 are rejected under 35 U.S.C. §103(a) as being obvious and therefore unpatentable over Carrera. More specifically, the Office Action indicates that Carrera teaches all limitations except that it does not expressly indicate ranking and placing in order all responses. Among others, the Office Action states that Carrera teaches matching answers in column 10 at lines 38-41 and recording of answers in column 11 at lines 35-41. After a thorough review of Carrera, however, Applicants respectfully submit that at least these features are not taught by this reference.

As with Forrest, Carrera promotes collaboration or discussion between players to determine an answer. This is specifically recited in column 10 beginning on line 38, which states that “[d]iscussion among team members is allowed in forming answers.” As discussed above in detail, collaboration between team members would undesirably remove the fun and challenge from the game. This is largely because each team would likely have identical responses ranked in an identical order. Thus, the step of comparing the responses as recited in the subject claims is not taught by Carrera.

Furthermore, the Office Action states that even though a step of ranking the responses is not expressly taught by Carrera, it nevertheless would have been obvious to rank and order the final response for a winning purpose. Thus, it is asserted, the discussion between the parent and child to come to a final response will inherently and informally rank and order the best answer. However, conferring to come to a final response is not consistent with the subject method for at least the reasons stated above, and teaches away from the step of comparing responses between team members. As such, it would not have been obvious to rank the responses as recited in the subject application based upon the teachings of Carrera.

Finally, the Office Action asserts that Carrera teaches recording answers by the players in column 11 beginning at about line 35. More specifically, Carrera states that “[i]f a player answers correctly, they place a colored peg 82 in a peg hole 81 under the appropriate category heading on their score sheet.” [Emphasis added.] This passage is directed keeping a score on a score sheet for winning the game, rather than teaching the recording of responses to a category. What’s more,

it is not possible to compare such scoring between team members, in the nature of the subject method and game, and this passage cannot be relied upon to teach a step of recording answers as recited in the subject claims. For at least these reasons, the subject claims, as presently amended, define over the teachings of Carrera.

CONCLUSION

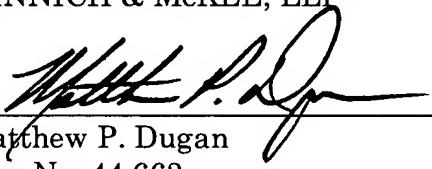
It is respectfully submitted that the foregoing amendments and discussion are fully responsive to the latest Office Action, and that the claims are in proper form and patentably distinguish over the documents of record for the reasons stated. Having addressed all of the outstanding objections and/or rejections, the subject application is now believed to be in condition for allowance. Reconsideration of the claims and an early notice of allowability is earnestly solicited.

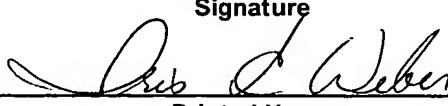
Alternatively, in the interests of compact prosecution and advancing this application to issue, Applicants respectfully request that the Examiner telephone the undersigned to discuss any of the foregoing or to make any suggestions that the Examiner may have to place the case in condition for allowance.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

08/16/2004
Date


Matthew P. Dugan
Reg. No. 44,663
1100 Superior Avenue
7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

Certificate of Mailing	
Under 37 C.F.R. § 1.8, I certify that this Amendment is being	
<input checked="" type="checkbox"/> deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.	
<input type="checkbox"/> transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.	
<input type="checkbox"/> deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AMENDMENT, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Express Mail Label No.:	Signature
	
Date	Printed Name
August 16, 2004	Iris E. Weber